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DATE: **October 19, 2010** JOB CODE:

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Name:	**William J. Allen**
Company/Firm:	**United States Patent and Trademark Office**
Telecopier No.:	**571-273-1443**
Client/Matter No.:	****OO-0145**
Application No.	**09/707,273**
Sender's Name:	**Jon M. Isaacson/Erika Eidsmoe**
Pages to Follow:	**21**

If transmission is not complete, please call our **Seattle Office** at **(206) 332-1380.**

COVER MESSAGE:

Attached hereto are the following documents:

1. Applicant Initiated Interview Request Form – (1 page)
2. Draft Response to Non-Final Office Action dated: August 24, 2010 (20 pages)

Thank You
--Erika Eidsmoe

THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED AND MAY CONTAIN INFORMATION THAT IS PRIVILEGED, CONFIDENTIAL AND EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAW. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERY OF THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL TO US AT THE ABOVE ADDRESS VIA THE U.S. POSTAL SERVICE. THANK YOU.

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Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No.: **OO-0145 First Named Applicant: Charles Eric Hunter

Examiner: William J. Allen Art Unit: 3625 Status of Application: Pending

Tentative Participants:

(1) William J. Allen (2) Jon M. Isaacson (60,436)

(3) (4)

Proposed Date of Interview: October 20, 2010 **Proposed Time:** 11am(ET)/8am(PT) **AM/PM**

Type of Interview Requested:

(1) ☑ **Telephonic** (2) ☐ **Personal** (3) ☐ **Video Conference**

Exhibit To Be Shown or Demonstrated: ☐ **YES** ☐ **NO**

If yes, provide brief description:

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) 101 rejections	Claims 40, 52, 64	(none)	☐	☐	☐
(2) 112, para 2, rejections	Claims 64-65,67,71	(none)	☐	☐	☐
(3) 112, para 1, rejections	Claims 40, 52, 64	(none)	☐	☐	☐
(4) 103 rejections	Claims 40, 52, 64	Wiser & Hamada	☐	☐	☐

☐ Continuation Sheet Attached

Brief Description of Argument to be Presented:

Regarding the 101 and the 112/2 rejections, applicants believe that the amendments and the arguments on pgs 11-13 and 16 of the attached draft overcome the rejections. Regarding the 112/1 and 103 rejections, applicants believe that the spec supports the claims as discussed on pgs 14-16 of the draft and that the art does not teach the claim recitations.

An interview was conducted on the above-identified application on .

NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

/Jon M. Isaacson/
Applicant/Applicant's Representative Signature

Jon M. Isaacson
Typed/Printed Name of Applicant or Representative

60,436
Registration Number, if applicable

Examiner/SPE Signature

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Office Action Dated: August 24, 2010

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Charles Eric Hunter, et al.

Confirmation No.: **8435**

Application No.: **09/707,273**

Group Art Unit: **3625**

Filing Date: **November 6, 2000**

Examiner: **William J. Allen**

For: **MUSIC DISTRIBUTION SYSTEMS**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY PURSUANT TO 37 CFR § 1.111

In response to the Official Action dated **August 24, 2010**, reconsideration is respectfully requested in view of the amendments and/or remarks as indicated below:

☐ **Amendments to the Specification** begin on page of this paper.

☒ **Amendments to the Claims** are reflected in the listing of the claims which begins on page 2 of this paper.

☐ **Amendments to the Drawings** begin on page of this paper and include an attached replacement sheet.

☒ **Remarks** begin on page 10 of this paper.

☐ **Request For Refund** submitted herewith.

☒ The Commissioner is hereby authorized to charge any fee deficiency, charge any additional fees, or credit any overpayment of fees, associated with this application in connection with this filing, or any future filing, submitted to the U.S. Patent and Trademark Office during the pendency of this application, to Deposit Account No. 23-3050.

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This listing of claims will replace all prior versions, and listings, of claims in the application.

Listing of Claims:

1. – 39. (Canceled)

40. (Currently amended) A method comprising:

receiving a consumer request for a music selection;

responsive to said consumer request, transmitting the music selection to an intermediate storage medium at a consumer site;

receiving an indication that at least a portion of the music selection has been recorded from the intermediate storage medium to a permanent storage medium located at the consumer site; and

responsive to receiving said indication, automatically charging the consumer for the music selection.

41. (Previously presented) The method of claim 40 wherein the automatically charging is done electronically.

42. (Canceled)

43. (Previously Presented) The method of claim 40 further comprising:

informing the consumer that the music selection is available for transmission to the intermediate storage medium via a peer-to-peer music sharing system used by said consumer; and

providing a mechanism for the consumer to request said music selection while at a website of said peer-to-peer music sharing system.

44. (Previously Presented) The method of claim 43 further comprising:

paying an operator of said peer-to-peer music sharing system for advertising and making music available for transmission to the intermediate storage medium.

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45. (Previously Presented) The method of claim 43 wherein the informing comprises:

placing a highlight within a catalog of said peer to peer music sharing system whenever catalog selections are available for transmission to the intermediate storage medium.

46. (Previously Presented) The method of claim 43, wherein the informing comprises:

placing an icon within a catalog of said peer to peer music sharing system whenever catalog selections are available for transmission to the intermediate storage medium.

47. (Previously Presented) The method of claim 43, further comprising:

creating a profile from consumer preference information provided by said peer-to-peer music sharing system.

48. (Previously Presented) The method of claim 40 further comprising:

transmitting to the consumer site, for storage on a storage medium at the consumer site, information identifying music selections available for transmission to the intermediate storage medium.

49. (Previously Presented) The method of claim 48 further comprising:

before automatically charging the consumer for the music selection, receiving an indication that the entire music selection has been recorded on the permanent storage medium.

50. (Previously Presented) The method of claim 49, further comprising:

communicating an order of said music selection to a central controller;

transferring copies of records of said order to a transmission scheduler;

communicating schedules created by said transmission scheduler to a satellite uplink facility for transmission of said order; and

transmitting via satellite said order to said customer site.

51. (Previously Presented) The method of claim 50, wherein said order communication comprises:

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an action selected from the group consisting of: using a home personal computer for ordering said music selection, using a cell phone for ordering said music selection, using a Personal Data Assistant wireless device for ordering said music selection; ordering said music selection is via wireless application protocol.

52. (Currently amended) A computer readable storage medium having computer executable instructions stored thereon, the instructions comprising:

instructions to receive a consumer request for a music selection;

instructions to transmit, responsive to said consumer request, the music selection to an intermediate storage medium at a consumer site;

instructions to receive an indication that at least a portion of the music selection has been recorded from the intermediate storage medium to a permanent storage medium located at the consumer site; and

instructions to automatically charge, responsive to said indication, the consumer for the music selection.

53. (Previously Presented) The computer readable medium of claim 52, wherein the instructions to automatically charge comprise instructions to automatically charge electronically.

54. (Canceled)

55. (Previously Presented) The computer readable of claim 52, the instructions further comprising:

instructions to inform the consumer that the music selection is available for transmission to the intermediate storage medium via a peer-to-peer music sharing system used by said consumer; and

instructions to provide a mechanism for the consumer to request said music selection while at a website of said peer-to-peer music sharing system.

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56. (Previously Presented) The computer readable of claim 55, the instructions further comprising:

instructions to pay an operator of said peer-to-peer music sharing system for advertising and making music available for transmission to the intermediate storage medium.

57. (Previously Presented) The computer readable of claim 55, wherein the instructions to inform comprise:

instructions to place a highlight within a catalog of said peer to peer music sharing system whenever catalog selections are available for transmission to the intermediate storage medium.

58. (Previously Presented) The computer readable of claim 55, wherein the instructions to inform comprise:

instructions to place an icon within a catalog of said peer-to-peer music sharing system whenever catalog selections are available for transmission to the intermediate storage medium.

59. (Previously Presented) The computer readable of claim 55, the instructions further comprising:

instructions to create a profile from consumer preference information provided by said peer-to-peer music sharing system.

60. (Previously Presented) The computer readable of claim 52, the instructions further comprising:

instructions to transmit to the consumer site, for storage on a storage medium at the consumer site, information identifying music selections available for transmission to the intermediate storage medium.

61. (Previously Presented) The computer readable of claim 60, the instructions further comprising:

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instructions to, before automatically charging the consumer for the music selection, receive an indication that the entire music selection has been recorded on the permanent storage medium.

62. (Previously Presented) The computer readable of claim 61, the instructions further comprising:

instructions to communicate an order of said music selection to a central controller;

instructions to transfer copies of records of said order to a transmission scheduler;

instructions to communicate schedules created by said transmission scheduler to a satellite uplink facility for transmission of said order; and

instructions to transmit via satellite said order to said customer site.

63. (Previously Presented) The computer readable of claim 62, wherein said order communication comprises an action selected from the group consisting of: using a home personal computer for ordering said music selection, using a cell phone for ordering said music selection, using a Personal Data Assistant wireless device for ordering said music selection; ordering said music selection is via wireless application protocol.

64. (Currently amended) An apparatus comprising:

~~a~~ means for receiving ~~mechanism configured to receive~~ a consumer request for a music selection;

~~a~~ means for transmitting ~~mechanism configured to transmit~~ the music selection, responsive to said consumer request, ~~the music selection~~ to an intermediate storage medium at a consumer site;

~~a~~ means for receiving ~~mechanism configured to receive~~ an indication that at least a portion of the music selection has been recorded from the intermediate storage medium to a permanent storage medium located at the consumer site; and

~~a~~ means for automatically charging ~~mechanism configured to automatically charge~~ the consumer for the music selection, ~~the automatically charging responsive~~ in response to receiving

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the indication that at least a portion of the music selection has been recorded on the permanent storage medium located at the consumer site.

65. (Currently amended) The apparatus of claim 64 further wherein the means for automatically charging ~~mechanism~~ is configured to automatically charge electronically.

66. (Canceled)

67. (Currently amended) The apparatus of claim 64 further comprising:

~~a~~ means for transmitting ~~mechanism configured to transmit~~ to the consumer site information identifying available music selections for recording on the storage medium.

68. – 70. (Canceled)

71. (Currently amended) The apparatus of claim 64 further comprising:

~~a transmitter configured to transmit~~ means for transmitting, for storage on a storage medium at the consumer site, information identifying music selections available for transmission to the intermediate storage medium.

72. (Canceled)

73. (New) The apparatus of claim 64, further comprising:

means for informing the consumer that the music selection is available for transmission to the intermediate storage medium via a peer-to-peer music sharing system used by said consumer; and

means for providing a mechanism for the consumer to request said music selection while at a website of said peer-to-peer music sharing system.

74. (New) The apparatus of claim 73, wherein the means for informing comprises:

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means for placing a highlight within a catalog of said peer to peer music sharing system whenever catalog selections are available for transmission to the intermediate storage medium.

75. (New) The apparatus of claim 73, wherein the means for informing comprises:

means for placing an icon within a catalog of said peer to peer music sharing system whenever catalog selections are available for transmission to the intermediate storage medium.

76. (New) The method of claim 40, further comprising:

transmitting pricing information for the music selection to a customer station located at the customer site; and

periodically transmitting updated pricing information for the music selection to the customer station;

wherein the automatically charging the customer for the music selection is done in accordance with the updated pricing information.

77. (New) The computer readable medium of claim 52, further comprising:

instructions to transmit pricing information for the music selection to a customer station located at the customer site; and

instructions to periodically transmit updated pricing information for the music selection to the customer station;

wherein the automatically charging the customer for the music selection is done in accordance with the updated pricing information.

78. (New) The apparatus of claim 64, further comprising:

means for transmitting pricing information for the music selection to a customer station located at the customer site; and

means for periodically transmitting updated pricing information for the music selection to the customer station;

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wherein the automatically charging the customer for the music selection is done in accordance with the updated pricing information.



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REMARKS

Office action summary

Claims 40-41, 43-53, 55-65, 67, and 71 are pending in the present application. Claims 40, 52, 64-65, 67, and 71 are presently amended. Claims 73-78 are presently amended. No claims are presently canceled. The following rejections were made in the office action of August 24, 2010 ("Office Action"):

- Claims 40-41, 43-53, 55-65, 67, and 71 were rejected under 35 USC § 101 as being directed to non-statutory subject matter.
- Claims 40-41, 43-53, 55-65, 67, and 71 were rejected under 35 USC § 112, ¶ 1, as failing to comply with the written description requirement.
- Claims 64-65, 67, and 71 were rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which is regarded as the invention.
- Claims 40-41, 48-53, 60-65, 67, and 71 were rejected under 35 USC § 103(a) as being unpatentable over Wiser, US Patent 7,263,497 ("Wiser"), in view of Hamada, US Patent 6,792,007 ("Hamada").
- Claims 43 and 55 were rejected under 35 USC § 103(a) as being unpatentable over Wiser in view of Hamada, and further in view of Williams, "MP3 All in One," Newsbytes, July 23, 1999 ("Williams").
- Claims 44 and 56 were rejected under 35 USC § 103(a) as being unpatentable over Wiser in view of Hamada and Williams, and further in view of Wolff, US Patent 6,247,047 ("Wolff").
- Claims 45-46 and claims 57-58 were deemed allowable if (1) rewritten in dependent form including all the limitations of their base claims and any intervening claims, and (2) the rejections under 35 USC §§ 101 and 112 were overcome.

The amendments and rejections discussed below. The examiner is respectfully urged to reconsider the application and withdraw the rejections. Should the examiner have any questions

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or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants' undersigned attorney, Jon M. Isaacson, at **206-332-1102**.

Rejections under 35 USC § 101

Claim 40 stands rejected under 35 USC § 101 as being directed to non-statutory subject matter. More particularly, the examiner found that the method of claim 40 is not a process within the meaning of 35 USC § 101 because (1) it does not satisfy the "machine-or-transformation" test, and (2) there is no clear indication on the record that the claim is not directed to an abstract idea. Office Action, pages 5-6. The Supreme Court has made clear that the machine-or-transformation test is not the sole test for determining whether a claim to a method is a process within the meaning of 35 USC § 101. *Bilski v. Kappos*, 95 USPQ2d 1001, 1006-07 (U.S. 2010). Rather, "the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101." *Id.*, at 1007. In addition, the Supreme Court reaffirmed that there are "three specific exceptions to § 101's broad patent-eligibility principles: 'laws of nature, physical phenomena, and abstract ideas.'" *Id.*, at 1005-06 (*citing Diamond v. Chakrabarty*, 206 USPQ 193, 197 (U.S. 1980)).

Preliminarily, applicants respectfully submit the examiner's statement of the standard for determining whether a method claim is directed to patent-eligible subject matters is in error. The examiner states that the standard for determining whether a method claim is directed to patent-eligible subject matters is: a method is likely patent-eligible if it meets the machine-or-transformation test unless there is a clear indication that the method is directed to an abstract idea, and a method is likely not patent eligible if it does not meet the machine-or-transformation test unless there is a clear indication that it is not directed to an abstract idea. Office Action, page 5. The Supreme Court indicated that the machine or transformation test is a tool for determining patent eligibility, but is not the sole test. *Bilski*, 95 USPQ at 1007. The examiner's standard essentially requires that a method claim pass the machine-or-transformation test unless there is a clear indication that the method is not directed to an abstract idea. This standard is

inconsistent with the Supreme Court's decision in *Bilski*, and therefore the examiner's standard is in error.

Applicants submit that claim 40 is not directed to an abstract idea. Claim 40 is directed to a method which comprises "responsive to [a] consumer request, transmitting the music selection to an intermediate storage medium at a consumer site," "receiving an indication that at least a portion of the music selection has been recorded on…a permanent storage medium located at the consumer site," and "responsive to receiving said indication, automatically charging the consumer for the music selection." These recitations, individually and collectively, are not directed to abstract ideas. For example, transmitting a music selection to a particular storage medium at a consumer site is not an abstract idea; this recitation requires transmitting of a specific thing to a specific location. Similarly, receiving a particular indication regarding the recording of a particular music selection and automatically charging a particular customer in response to receiving that indication are not abstract ideas. Thus, the individual recitations of claim 40, and claim 40 taken as a whole, are not directed to an abstract idea. Accordingly, applicants submit that claim 40 is directed to statutory subject matter and request withdrawal of the rejection of claim 40 under 35 USC § 101.

Claims 41 and 43-51 stand rejected under 35 USC § 101 as being directed to non-statutory subject matter. Claims 41 and 43-51 depend, directly or indirectly, from claim 40. For at least the reasons that claim 40 is directed to statutory subject, claims 41 and 43-51 are also directed to statutory subject matter. Accordingly, applicants request withdrawal of the rejection of claims 41 and 43-51 under 35 USC § 101.

Claims 52-53 and 55-63 stand rejected under 35 USC § 101 as being directed to non-statutory subject matter. More specifically, the examiner found that the broadest reasonable interpretation of a "computer readable medium" in claims 52-53 and 55-63 included both statutory media and non-statutory media. Office Action, page 6. Without conceding the propriety of the rejection, in an effort to advance prosecution of the present application, applicants presently amend claim 52 to recite a "computer readable storage medium." In the Office Action, the examiner found that the specification describes "various media such as permanent and intermediate *storage media* (e.g. hard disk, cd, etc.), as well as transmission

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media (e.g. satellite transmission media)." *Id.* (emphasis added). In light of the examiner's findings, applicants submit that the broadest reasonable interpretation of the term "storage medium" is limited statutory media. Accordingly, applicants submit that claims 52-53 and 55-63 are directed to statutory subject matter and request that the rejection of claims 52-53 and 55-62 under 35 USC § 101.

Claim 64 stands rejected under 35 USC § 101 as being directed to non-statutory subject matter. More specifically, the examiner found that claim 64 is drawn to "specific program structure and not necessarily to any structure," and concluded that claim 64 was directed to software per se. Applicants traverse the examiner's finding that claim 64 is directed to software per se. As presently amended, claim 64 is directed to an apparatus which comprises "means for transmitting the music selection, responsive to said consumer request, to an intermediate storage medium at a consumer site." The recited means for transmitting cannot reasonably be interpreted as software per se. Even if pure software included instructions to transmit a music selection to an intermediate storage medium at a consumer site, the software itself (i.e., the instructions alone) could not possible transmit the music selection to the intermediate storage medium. Thus, even if the recited means for transmitting includes software instructions to transmit the music selection to the intermediate storage medium, the means for transmitting must include some non-software component which is capable of actually transmitting the music selection to the intermediate storage medium. For at least these reasons, applicants submit that claim 64 is not directed to software per se, and applicants request withdrawal of the rejection of claim 64 under 35 USC § 101.

Claims 65, 67, and 71 stand rejected under 35 USC § 101 as being directed to non-statutory subject matter for being directed to software per se. Claims 65, 67, and 71 depend from claim 64. For at lease the reasons that claims 64 is not directed to software per se, applicants submit that claims 65, 67, and 71 are also not directed to software per se. Accordingly, applicants request withdrawal of the rejection of claims 65, 67, and 71 under 35 USC § 101.

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Rejections under 35 USC § 112, ¶ 1

Claim 40 stands rejected under 35 USC § 112, ¶ 1, as failing to comply with the written description requirement. Claim 40 recites "receiving an indication that at least a portion of the music selection has been recorded from the intermediate storage medium to a permanent storage medium located at the consumer site." In the Office Action, the examiner found that "there is no express support for the...reception of an indication" and there is no support for an indication which indicates that a music selection has been recorded "from [a] storage medium to a permanent storage medium." Office Action, page 8. For examination purposes, this recitation of claim 40 was "interpreted as 'receiving an indication that at least a portion of the music selection has been stored in intermediate storage and subsequently stored in permanent storage' (i.e. not necessarily transferred from [sic] intermediate to permanent storage)." *Id.*, at page 9.

Applicants respectfully traverse the findings that the specification does not support "receiving an indication that at least a portion of the music selection has been recorded from the intermediate storage medium to a permanent storage medium located at the consumer site," as recited by claim 40. As noted by the examiner in the Office Action, applicants' specification describes:

> In certain embodiments, the customer leaves the channel of his DBS (or cable) receiver on the designated "music channel" until the requested recording is downloaded to intermediate storage in storage module 130. When the download is completed, the customer user interface flashes a cue such as "YOU'VE GOT TUNES", following which the customer may permanently record the music, with automatic billing that appears on the customer's consolidated monthly statement.

Specification, page 26, lines 9-17. Regarding the receiving of an indication, one of ordinary skill in the art would understand from this portion of the specification that if automatic billing of a customer's account happens in response to the customer permanently recording music, then some indication of the permanent recording of the music must be received in order to bill the customer's account. Thus, at least this portion of the specification provides support for the receiving of an indication.

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Regarding the music item being recorded from an intermediate storage medium to a permanent storage medium, the above-cited portion of the specification explicitly describes that "[w]hen the download [of music to intermediate storage] is completed,...the customer may permanently record the music." *Id.* at page 26, lines 12-15. Based on the way in which claim 40 was interpreted for purposes of examination, the examiner appears to concede that this portion of the specification provides support for a music selection item to be recorded on an intermediate storage medium and subsequently recorded on a permanent storage medium. Office Action, page 9. Furthermore, in another portion not acknowledged in the Office Action, the specification describes that when a user station is "provided with [an intermediate] storage module 130 having a substantial data storage capacity, it is possible for many *recordings to be immediately available to the customer for permanent recording.*" *Id.*, at page 28, lines15-18 (emphasis added). Because the specification describes that music can be downloaded to an intermediate storage medium and subsequently recorded on a permanent storage medium, and that the music in the intermediate storage medium is available to the customer for permanent recording, one of ordinary skill in the art would understand that the specification describes that the music can be recorded, directly or indirectly, from the intermediate storage medium to the permanent storage medium. Thus, applicants submit that the specification provides support for the recording of music from an intermediate storage medium to a permanent storage medium.

For at least the foregoing reasons, applicants submit that the specification supports "receiving an indication that at least a portion of the music selection has been recorded from the intermediate storage medium to a permanent storage medium located at the consumer site," as recited by claim 40. Thus, claim 40 complies with the written description requirement. Accordingly, applicants request withdrawal of the rejection of claim 40 under 35 USC § 112, ¶ 1.

Claims 52 and 64 stand rejected under 35 USC § 112, ¶ 1, as failing to comply with the written description requirement. Although different in scope from claim 40, claims 52 and 64 contain recitations similar to those recitations of claim 40 discussed above. For at least the reasons that claim 40 complies with the written description requirement, applicants submit that claims 52 and 64 comply with the written description requirement. Accordingly, applicants request withdrawal of the rejection of claims 52 and 64 under 35 USC § 112, ¶ 1.

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Claims 41, 43-51, 53, 55-63, 65, 67, and 71 stand rejected under 35 USC § 112, ¶ 1, as failing to comply with the written description requirement. Claims 41, 43-51, 53, 55-63, 65, 67, and 71 depend, directly or indirectly from claims 40, 52, and 64. Inasmuch as claims 40, 52, and 64 comply with the written description requirement, applicants submit that claims 41, 43-51, 53, 55-63, 65, 67, and 71 comply with the written description requirement. Accordingly, applicants request withdrawal of the rejection of claims 41, 43-51, 53, 55-63, 65, 67, and 71 under 35 USC § 112, ¶ 1.

Rejections under 35 USC § 112, ¶ 2

Claims 64-65, 67, and 71 stand rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the examiner found that these claims recited a number of mechanisms, each with a recited function, and that the claims did not describe the structure corresponding to the recited function. Office Action, page 10. The examiner further found that "what may or may not comprise the recited mechanisms and what is required by the claim is unclear" and that "the various recited elements fail to provide any structure and merely recite functionally descriptive material and abstract ideas." *Id.*

Without conceding the propriety of the rejections or the examiner's findings, applicants presently amend claims 64-65, 67, and 71. As amended, claim 64 recites "means for transmitting," "means for receiving," and "means for automatically charging" where the claim previously recited a number of mechanisms. Similar amendments are made to claims 65, 67, and 71. Inasmuch as claims 64-65, 67, and 71 recite "means for" language, applicants submit that the claims invoke 35 USC § 112, ¶ 6, which indicates that such claims "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Thus, applicants submit that the scope of the recitations in claims 64-65, 67, and 71 is clear. Accordingly, applicants request withdrawal of the rejection of claims 64-65, 67, and 71 under 35 USC § 112, ¶ 2.

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Rejections under 35 USC § 103(a)

Claim 40 stands rejected under 35 USC § 103(a) as being unpatentable over Wiser in view of Hamada. Applicants respectfully traverse the rejection of claim 40. For the reasons that follow, applicants respectfully submit that the examiner has not established a *prima facie* case of obviousness because the cited references fail to render obvious the recitations of claim 40 and because the reasoning for combing the cited references is insufficient to support a *prima facie* case of obviousness.

First, the cited references fail to render obvious the recitations of claim 40. Claim 40 recites "receiving an indication that at least a portion of the music selection has been recorded from the intermediate storage medium to a permanent storage medium located at the consumer site." Regarding the Wiser reference, the examiner indicates that Wiser teaches that charging for media is done prior to the storage of media in permanent storage media. Office Action, at page 12. The examiner recognizes that "Wiser does not expressly teach where the charging is *in response to [receiving] an indication that at least a portion of the media has been stored in a permanent storage medium at the consumer site* (i.e. charging takes place after the media is permanently stored)." *Id.* (emphasis in original). To cure this deficiency in Wiser, the examiner cites to Hamada as teaching "where the charging is *in response to [receiving] an indication that at least a portion of the media has been stored in a permanent storage medium at the consumer site* [see at least: col. 6 lines 36-52, col. 7 lines 55-67, Fig. 14 #s206-208]." *Id.* (emphasis in original). In a portion cited by the examiner, Hamada teaches:

> When the cursor is set to the lyrics display button 22 in this state and the enter key is pressed (hereinafter, the operation of setting the cursor to the button and pressing the enter key is referred to as "pressing the button"), the lyrics of the piece of music are displayed in the text display area 21C at a timing synchronized with the audio data. In a similar manner, when the profile display button 23 or the information display button 24 is pressed, the profile of the artist, concert information, etc., corresponding to the piece of music, are displayed in the text display area 21C. In a manner as described above, it is possible for the viewer-listener to be informed of what kind of ***piece of music is being streamed currently*** and to be informed of the detailed information of each piece of music.

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> When the viewer-listener wishes to purchase the piece of music the viewer-listener has test-listened, the viewer-listener presses the download button 28. When the download button 28 is pressed, the audio data of the selected piece of ***music is downloaded and stored in the storage device*** 13. Together with the audio data of the piece of music, the lyrics data thereof, the profile information of the artist, the still-image data of the jacket, etc., can also be downloaded. Each time a piece of music is downloaded, the information is stored in the IC card within the IRD 12. The information stored in the IC card is stored by the account server 5, for example, once a month. This makes it possible to protect the copyright of the pieces of music to be downloaded.

Hamada, col. 7, lines 41-67 (emphases added). As describes in Hamada, a listener can test a piece of music by listening to the music as it is streamed to the listener. After that, Hamada describes that the user can download the music and store it in a storage device, and the user is billed for the download. However, Hamada fails to teach or suggest that the music "has been recorded from [an] intermediate storage medium [at a consumer site] to a permanent storage medium located at the consumer site," as recited by claim 40. Further, as recognized by the examiner, Wiser does not teach or suggest this recitation of claim 40. Thus, Wiser in view of Hamada fail to render obvious "receiving an indication that at least a portion of the music selection has been recorded from the intermediate storage medium to a permanent storage medium located at the consumer site," as recited by claim 40.

Second, the reasoning for combing the cited references is insufficient to support a *prima facie* case of obviousness of claim 40. "The key to supporting any rejection under 35 USC § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP § 2142 (*citing KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (U.S. 2007)). Further "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006). In the Office Action, the examiner recognizes that Wiser teaches that a user is charged for media prior to the user being able to download the media. Office Action, page 12. Later, the examiner reasons that one of ordinary skill in the art would have combined the teachings of Hamada with the teachings of Wiser because "the invention of Hamada would improve the

invention of Wiser by providing a system and method which are more capable of ensuring the protection of data with respect to illicit transfer of specific data." *Id.* Essentially, the examiner is arguing that, even though Wiser had a system in place for deterring illicit transfer of data by charging a user prior to download, one of ordinary skill in the art would have used the method taught by Wiser instead because Wiser's method is "more capable of ensuring the protection of data with respect to illicit transfers." Applicants traverse the examiner's unsupported conclusions that Wiser system would better protect against illicit transfers or that one or ordinary skill in the art would have used Wiser's methods in Hamada's system even though Hamada already had a method for protecting against illicit transfers. These conclusory statements are not supported by factual findings or the rational underpinning required to support a *prima facie* case of obviousness. Thus, the examiner's unsupported conclusory statements are insufficient to establish a *prima facie* case of obviousness.

For at least the foregoing reasons, applicants submit that the cited references fail to render obvious the recitations of claim 40 and the reasoning for combing the cited references is insufficient to support a *prima facie* case of obviousness. Thus, the examiner has not established a *prima facie* case of obviousness of claim 40. Accordingly, applicants request withdrawal of the rejection of claim 40 under 35 USC § 103(a).

Claims 52 and 64 stand rejected under 35 USC § 103(a) as being unpatentable over Wiser in view of Hamada. Although different in scope from claim 40, claims 52 and 64 contain recitations which are similar to those recitations of claim 40 discussed above. For at least the reasons discussed above with respect to claim 40, applicants submit that Wiser and Hamada fail to render obvious claims 52 and 64 and that a *prima facie* case of obviousness of claims 52 and 64 has not been established. Accordingly, applicants respectfully request withdrawal of the rejections of claims 52 and 64 under 35 USC § 103(a).

Claims 40-41, 48-53, 60-65, 67, and 71 were rejected under 35 USC § 103(a) as being unpatentable over Wiser in view of Hamada. **Claims 43 and 55** were rejected under 35 USC § 103(a) as being unpatentable over Wiser in view of Hamada, and further in view of Williams. **Claims 44 and 56** were rejected under 35 USC § 103(a) as being unpatentable over Wiser in view of Hamada and Williams, and further in view of Wolff. Claims 40-41, 43-44, 48-53, 55-56,

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60-65, 67, and 71 depend from claims 40, 52, and 64. Applicants submit that Williams and Wolff fail to cure the deficiencies of Wiser in view of Hamada to render obvious claims 40, 52, and 64, and the examiner has not cited to Williams and Wolff for this purpose. Thus, for at least the reasons that the cited art fails to render obvious claims 40, 52, and 64, applicants submit that claims the cited art fails to render obvious claims 40-41, 43-44, 48-53, 55-56, 60-65, 67, and 71. Accordingly, applicants request withdrawal of the rejections of claims 40-41, 43-44, 48-53, 55-56, 60-65, 67, and 71 under 35 USC § 103(a).

New claims

Applicants presently add new claims 73-79. Claims 73-79 depend, directly or indirectly, from claims 40, 52, and 64. For at least the reasons that claims 40, 52, and 64 are in condition for allowance, applicants submit that claims 73-79 are also in condition for allowance.

Conclusion

Applicants believe that the present remarks are responsive to each of the points raised by the examiner in the Office Action, and submit that claims 40-41, 43-53, 55-65, 67, 71, and 73-79 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the examiner's earliest convenience is earnestly solicited.

Date: DRAFT

Jon M. Isaacson
Registration No. 60,436

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

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